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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/667,252	09/19/2003	David R. Jones IV	24935D	1138
22889	7590	12/06/2004	EXAMINER	
OWENS CORNING 2790 COLUMBUS ROAD GRANVILLE, OH 43023			ADDIE, RAYMOND W	
			ART UNIT	PAPER NUMBER
			3671	

DATE MAILED: 12/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/667,252

Applicant(s)

JONES ET AL.

Examiner

Raymond W. Addie

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 19-22 and 25-38 is/are pending in the application.
- 4a) Of the above claim(s) 25-38 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 19-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>4/8/04, 7/28/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election of Group VI, claims 19-22 in the reply filed on 9/14/04 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). It is noted that all non-elected claims 1-18, 23, 24 have been cancelled.

Further, (New) Claims 25-38 have been withdrawn as being directed to Non-Elected subject matter. Applicant's response filed 9/14/04 canceled claims 1-18, 23, 24, which explicitly contained the Non-Elected subject matter now introduced as New dependent claims 25-38. Since the subject matter of the newly filed claims were explicitly restricted in the Last Office Action, newly filed claims 25-38 are considered to be Non-elected claims, because new claims 25-38 only recite what was originally restricted in the Last Office Action.

Claim Objections

2. Claim 19 is objected to because of the following informalities: Claim 19 requires a fiber having a melting point "above about 330⁰F. It is unclear as to whether the melting point of the fiber is above 330⁰F or if the melting point of the fiber is approximately 330⁰F and above. Hence the scope of the range claimed is unclear.

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Is the melting point of the fibers above 330⁰F, or is the melting point of the fibers above 329⁰F, 327⁰F or possibly above 300⁰F?

Appropriate correction is required.

Double Patenting

3. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claim 19 is rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 1 of prior U.S. Patent No. 6648547. This is a double patenting rejection.

Although the claims are not identical, the difference, which is drawn to the melting temperature of the fibers in the non-woven mat, is not a patentable distinction, since the patented claim requires a melting point above 320F and the application claim requires a melting point above 330F, which is included in the limitation of the patented claim.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 19-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Marzocchi et al. # 4,362,780.

Marzocchi et al. discloses a method of improving a paved surface comprising the steps:

Applying a layer of liquefied asphalt on a surface.

Applying a non-woven mat over the liquefied asphalt.

Applying a layer of paving material over the mat.

Wherein the mat comprises mineral fibers.

Although Marzocchi et al. does not disclose the melting point(temp.) of the mineral fibers, Marzocchi et al. explicitly recites the use of glass, fusible rock or slag, ceramic or aluminum silicate fibers. Further it is inherent that the cited mineral fibers have a melting point above 350⁰F. See Col. 3.

With respect to claims 20-22 although Marzocchi et al. does not disclose what would occur if a 4 ounce sample of the mat were held in an oven at a certain temp. and time, nor what would occur to the mat if it were subjected to 90% of its load strength,

Marzocchi et al. explicitly recites a mat comprising nonwoven fibers made from mineral fibers, such as glass fibers, which is identical to the mat claimed in claim 19 and disclosed on page 11. As clearly admitted by the Applicant, "A glass mat is thermally stable and does not melt or shrink when exposed to hot paving material".

Hence, it is inherent Marzocchi et al. discloses a method of improving a paved surface, utilizing a mat comprising non-woven mineral fibers, such as glass, wherein the mat is resistant to shrinkage and does not elongate greater than 5% when exposed to 90% of the mats load strength, as claimed.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Nachtman et al. discloses a method of treating a surface. Perry, Jr. et al. # 5,827,430 discloses a non-woven filter element comprising a fiber base and a binder material. Gallagher et al. # 5,869,413 discloses a method of making fiber based mats.

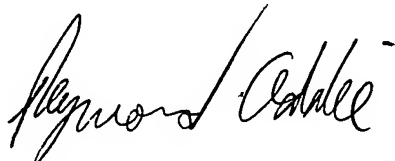
6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raymond W. Addie whose telephone number is 703 305-0135. The examiner can normally be reached on 8-2, 6-8.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas B. Will can be reached on 703 308-3870. The fax phone number

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for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Raymond Addie".

**Raymond Addie
Patent Examiner
Group 3600**

11/30/04